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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,845	06/13/2000	Mark Rosenberg	5547	5201

38598 7590 02/15/2005

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,845

Applicant(s)

ROSENBERG, MARK

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,43-48 and 85-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,43-48 and 85-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the request for continued examination filed on January 19, 2005. Amendments to claims 1, 43 and 86 and addition of claim 91 made by the Applicants in their request have been entered. Objection to the specification, claim rejections made under 35 USC § 112 and made under 35 USC § 101 in the office action mailed on October 18, 2004 are withdrawn by the examiner in view of the amendments. Claims 1-6, 43-48 and 85-91 are pending in the application and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 43-48 and 85-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelman (US Patent 6,064,986) in view of Hagan (US Patent 6,061,661) and further in view of Fabozzi et al (Reference U)

With reference to claims 1, 2, 6, 43, 44, 48, 85, 86, 87 and 90, Edelman teaches a computerized method, a computer memory (See Edelman Column 29 lines 1-5) and a computer readable medium providing instructions (See Edelman Column 10 lines 44-50) for providing an investment structure, the method comprising: receiving funds to be invested (See Edelman Claim 1c); providing a fixed component, the fixed component investing a first portion of funds and generating principal plus fixed interest (See Edelman Column 17 lines 56-59 and Column 17 line

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66 – Column 18 line 3); providing a contingent component, the contingent component investing a second portion of the funds and generating contingent interest (See Edelman Column 26 lines 38-43); wherein at least a portion of the fixed interest is re-invested in the fixed component (See Edelman Column 21 lines 61-64) and at least a portion of the contingent interest is re-invested in the contingent component (See Edelman Column 21 lines 61-64); determining, via a computer system, when to end an investment period based on parameters (See Edelman Column 11 lines 10-17, Column 25 lines 54-56 and Claim 2d, 2e); and distributing all of the fixed component, the contingent component, the fixed interest, and the contingent interest when the investment period has ended (See Edelman Claim 1m). Contingent component is interpreted to include equity investments like S&P 500 Index because their returns are not fixed and their performance is contingent on the performance of individual securities that make up the index. Edelman also teaches the steps of including using a trustee for investing the fixed component (See Edelman claim 1f) and distributing the initial investment and accrued interest after an investment period (See Edelman claim 1m, Column 21 lines 53-55). The condition “at least one of when the predetermined period of time has expired and when the predetermined event has occurred” is interpreted to include the condition “when the investment period has ended” including a seven-year period. Transmitting the resources in accordance with the predetermined criteria to the beneficiary is interpreted to include distributing all of the fixed component, the contingent component, the fixed interest, and the contingent interest. The memory in claims 43, 44, 46-48 is interpreted be strictly computer memory only.

Edelman does not explicitly teach the steps of using a partnership for investing the contingent component, the fixed component invests sixty to ninety percent of the funds in the

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fixed component and the contingent component invests ten to forty percent of the funds in the contingent component.

Hagan teaches the step of using a limited partnership for investing. Limited partnerships are a type of partnership that limits the liability of the limited partners. Using this form of investment structure enables the pass through of income while limiting the liability of the limited partners.

Both Hagan and Edelman are concerned with the problem of facilitating and administering investments for investor clients. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Hagan to the disclosure of Edelman. The combination of the disclosures taken as a whole suggests that the investors would have benefited from the advantages offered to at least a part of their investments by the partnership structure.

Edelman and Hagan combined do not explicitly teach the steps wherein the fixed component invests sixty to ninety percent of the funds in the fixed component and wherein the contingent component invests ten to forty percent of the funds in the contingent component.

Fabozzi teaches the steps wherein the fixed component invests sixty to ninety percent of the funds in the fixed component (See Fabozzi page 947 Treasury and agency securities) and wherein the contingent component invests ten to forty percent of the funds in the contingent component. The percentile range covered by Fabozzi includes the range claimed in the invention. Since the investment includes only the Fixed and Contingent components, the percentage invested in the contingent component will be a complement of the percentage invested in the fixed component. Hence if ninety percent is invested in the fixed component then ten percent

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will be invested in the contingent component. Similarly if sixty percent is invested in the fixed component then by default forty percent will be invested in the contingent component.

Fabozzi, Hagan and Edelman are all concerned with the problem of facilitating and administering investments for investor clients. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine these steps to the combined disclosures of Hagan and Edelman. The combination of the disclosures taken as a whole suggests that the investors would have benefited from the diversification of risk provided by investing the proportions in the fixed and contingent components.

With reference to claims 4, 5, 46, 47, 88, 89 and 91, Fabozzi teaches the steps wherein the investing the first portion step includes investing the fixed component in one or more of the following: treasury notes, AAA-rated securities, AA-rated securities, municipal bond notes, or variable rate notes (See Fabozzi pages 5-6, 419 and 420); and wherein the investing contingent component includes one or more of the following: futures, options, or forward positions (See Fabozzi Page 669)

Response to Arguments

4. Applicant's arguments with respect to claims 1-6, 43-48 and 85-90 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

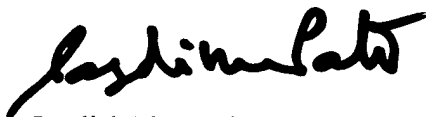
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Vincent Millin can be reached at (703) 308-1065. The fax phone number for the Patent Office where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian
February 7, 2005

A handwritten signature in black ink, appearing to read 'Jagdish N. Patel', written in a cursive style.

Jagdish N. Patel
Primary Examiner